

208456US67



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Yu Sung (Eduardo) YEH, et al.

EXAMINER: ALVAREZ, R.

SERIAL NO. 09/207,954

FILED: December 9, 1998

GROUP ART UNIT: 3622

CPA FILED: January 29, 2002

FOR: INTEGRATED, INTERACTIVE TELEPHONE AND COMPUTER NETWORK
COMMUNICATIONS SYSTEM

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a reply to the Examiner's answer re-dated March 11, 2004 after the first mailed Examiner's Answer was never received. For the reasons set forth below, it is believed that the Examiner's Answer fails to establish that Claims 35-37, 45 and 46 in the above-identified patent application are unpatentable.

REMARKS

The Examiner's Answer has not corrected any of the deficiencies of the final Office Action, and the outstanding final rejection should therefore be reversed. Counter-points to each of the points raised in the Examiner's Answer are provided below.

"Advertisements" in the Context of the '189 Patent Are Not "Marketing Messages"

As discussed in the Appeal Brief, the '189 patent only discloses that a particular file is available for download during a computer-based teleconference, not that there is any marketing message related thereto. This is evident from col. 13, lines 25-29, which states "Because it is possible for different members to post advertisements for files having the same name (though a single member can not post two files of the same name) it is necessary to check both the file name and which member is attempting to post the advertisement."

The Examiner's Answer tries to justify its position that the "advertisements" are marketing messages by quoting to Webster's Collegiate Dictionary's definition of marketing as "the process or technique of promoting, and distributing a product or service" and joining that definition with an allegation that the '189 patent "promot[es]" to the two parties that a file is available." It is respectfully submitted that there is no "promoting" of the file at all in the sense of a marketing message. Webster's Collegiate Dictionary, cited as an authority by the Examiner's answer defines "promote" as "to present (merchandise) for buyer acceptance through advertising, publicity or discounting." The Office Action has not shown that there is any "buyer acceptance" or that the files of the '189 patent are purchased or that either party is a buyer. In fact, the opposite is clear from the acknowledgement in the Examiner's Answer that the environment is a file sharing environment. Moreover, nothing in the '189 patent indicates that the shared file is a "product" or "service" in the context of a marketing message. Thus, the Examiner's Answer has not shown that a marketing message is disclosed in the '189 patent.

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The Claimed Use of a Server

In the last paragraph of page 5, the Office Action alleges that Mendler, teaches on page 3, paragraph 4, “putting the functions of the system in a ‘client-server graphical environment’ which therefore teaches that the steps are automated.” The cited paragraph does not disclose that the claimed features are automated. Rather, that paragraph discusses that some irrelevant features are automated within a different company, Bell Atlantic, but does not provide a link to the claimed features. Moreover, even the reference to the “Friends and Family” is a reference to a billing system that controls discounts, not to the deliverance of a marketing message by a server. The failure of the Examiner's Answer to show that the server performs each of the recited server-based steps requires that the rejection be found to be unsupported.

In addition, the first full paragraph of page 6 of the Examiner's Answer repeats the unsubstantiated allegation that “Mendler … teaches receiving a telephone call from a caller at said server.” Mendler, however, even teaches away from that limitation by teaching in paragraph 3 of page 3 that “customers are on the line with customer service representatives.” This is clearly not teaching that customers call servers, as alleged, but rather that customers call people.

The Challenge of Official Notice Was Proper

The Examiner's Answer seeks to avoid having to support its Official Notice by alleging that “applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where *In re Boon* is mentioned.” This

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allegation misses the points that (1) a reasonable doubt was cast on the alleged fact by showing that the relied upon reference did not show what was alleged in the Official Notice and (2) the Examiner's Answer mischaracterizes the law. First, given that a reasonable doubt has been created, it is respectfully submitted that Official Notice is improper. Second, MPEP 2144.03 does not contain the test espoused by the Examiner's Answer and does not appear to even cite In re Boon. In fact, the cited section is contrary to the positions taken by the Examiner's Answer and states that the "examiner must provide documentary evidence in the next Office action if the rejection is maintained." Moreover, 2144.03(c) even states that "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." The Examiner's Answer has not done this, and therefore no inference should be drawn that the examiner could have done this.

Conclusion

It is respectfully requested that the outstanding rejection be REVERSED.

Respectfully submitted,

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